

REMARKS

The Applicants submit this Amendment and Request for Reconsideration in response to the Office Action mailed on 28 September 2006.

In the present Amendment, the Applicants amend claims 7, 9, 11, 13-16, 23-28, and 33-38. The Applicants respectfully submit that no new matter has been added by the amendment of such claims; the amended limitations are fully supported by the application as originally filed (see e.g. the present application on page 17 at lines 18-20; page 3 at lines 4-6 and lines 18-21; page 4 at lines 22-29; page 8 at lines 23-30; page 10 at lines 4-13; and page 13 at lines 2-7).

The Applicants respectfully request entry of the Amendment and reconsideration of such claims. The Applicants acknowledge the Examiner's indication that the Office Action of 28 September 2006 was deemed final. For reasons stated later below, however, the Applicants respectfully submit that such indication of finality was premature, and therefore respectfully request entry of this amendment for clarification of the claim language and allowance of the application.

In the Office Action of 28 September 2006, the Examiner rejected claims 7, 9, 11, 13-16, 23-28, and 33-38 under 35 U.S.C. § 103(a) as being unpatentable over Thome et al. (U.S. Patent Application Publication No. 2004/0203620) and further in view of Mittal (U.S. Patent Application Publication No. 2004/0043788). In response, the Applicants respectfully disagree and submit that all pending claims are allowable over the prior art of record for at least the following reasons.

For a proper rejection under § 103, the prior art in combination must teach or suggest each and every limitation of the claims. In addition, there must be an adequate suggestion or motivation to combine the teachings of the prior art.

In the present case, the prior art in combination fails to teach or suggest each and every limitation of the claims. As is already well-established, Thome et al. describe an SMS message that includes a time stamp field, a time offset field, and a UTC/Local field. See Thome et al., “UTC or Local Field 624” and “Time Offset Field 620” in FIG. 6 as well as paragraphs 37, 41, and 45. In the rejection, the Examiner also directs the Applicants’ attention to paragraph 35 of Thome et al. which relates to the “UTC or Local Field 624” of the SMS message.

The Applicants respectfully submit that Thome et al. fail to teach or suggest a *programmed indication* which is programmed as a fixed value for indicating a timestamp mode of operation of a home message center, for each one of a plurality of SMS messages. UTC or Local Field 624 data in Thome et al. does not teach or suggest any programmed indication which is programmed as a fixed value in any R-UIM to indicate a timestamp mode of operation of a home message center. The “UTC or Local Field 624” of Thome et al. is provided in each SMS message, on a message-by-message basis, and is not a programmed indication.

In the present techniques, the single programmed indication is programmed as a fixed value “for use with SMS message timestamps of each one of a plurality of SMS messages communicated between the home message center and the mobile communication device” as claimed. The programmed indication in the R-UIM of the present application relates to a UTC mode or non-UTC mode of operation of a home message center associated with the mobile device – not relating to an indication in the SMS message itself.

During prosecution, claims should be given their broadest reasonable interpretation. One ordinarily skilled in the art would interpret the claims as outlined above. If the Examiner is failing to interpret the claims as described above, then the Applicants respectfully submit that such interpretation is not reasonable.

Based on the above, the Applicants respectfully request for the allowance of all claims as amended.

As described above, the Applicants respectfully submit that Thome et al. fail to teach or suggest a programmed indication which is programmed as a fixed value for indicating a timestamp mode of operation as claimed. Even if it did (which it does not), however, the Applicants also respectfully submit that there would be no adequate suggestion or motivation to modify the teachings of Thome et al. with any such programmed indication in memory of an R-UIIM (not explicitly described in Thome et al.), programmed as a fixed value for indicating a timestamp mode of operation of a home message center.

The Applicants respectfully submit that the Examiner has not provided an adequate showing of suggestion or motivation to combine the teachings of the references as suggested. Note that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test of an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art."

In the Office Action, the Examiner's "Response to Arguments" on page 8 of the Office Action are stated as follows:

Regarding claims 7,9,11,13,16,23,26 and 27, the Applicant argues on page 12 that there is no suggestion or motivation to one ordinarily skilled in the art to provide the "UTC or Local Field 624" of Thome et al in a removable user identity module (R-UIIM) as the Examiner argues as well as to provide Thome et al. with a timestamp mode indicator field in memory of an R-UIIM. Examiner respectfully disagrees with the arguments. Thome teaches that mobile station processes time stamp value in the incoming messages (page 4, paragraph 0043, page 5, paragraph 0049) and suggests memory that includes different types of memory (see page 2, paragraph 0027). Therefore, it is obvious for one ordinary skill in the art to add a removable memory as taught by Mital in the mobile station of Thome in order to provide a time stamp mode indicator field.

However, the Applicants respectfully disagree with the Examiner's argument above.

Comparing the two approaches (techniques of the present application and those of Thome et al.), the teachings of the present application utilize a *programmed indication* which is programmed as a fixed value for indicating a timestamp mode of operation of a home message center, for each one of a plurality of SMS messages. UTC or Local Field 624 data in Thome et al. does not teach or suggest any programmed indication which is programmed as a fixed value in any R-UIM to indicate a timestamp mode of operation of a home message center. The “UTC or Local Field 624” of Thome et al. is provided in each SMS message, on a message-by-message basis, and is not a programmed indication. *If such teachings of Thome et al. were to be modified as suggested by the Examiner, then this would thwart the primary intent and technique of Thome et al., which is to control the timestamp alteration from within the SMS message itself.*

As apparent, these techniques demonstrate two different approaches, and one approach may suggest a teaching away from the other approach. Thus, there is no suggestion or motivation to modify Thome et al. to provide a programmed indication which is programmed as a fixed value in a R-UIM (not explicitly described in Thome et al.) as argued by the Examiner, for use with SMS message timestamps of each one of a plurality of SMS messages communicated between the home message center and the mobile communication device. Again, such modification would lead to altering the primary intent and technique of Thome et al., which is to control the timestamp alteration from within the SMS message itself.

The Examiner also states in the present Office Action that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Thome et al to incorporate the removable user identity module with the Thome’s invention in order to provide a user to use the removable user identity module with any other mobile device such that he/she can get the benefit of using the removable user identity module without having any inconvenience” (see page 3 of the Office Action of 28 September 2006). Even if this were true, however, such benefit would need to be considered together with other considerations such as the one described above: altering the primary intent and technique of Thome et al. which is to control the timestamp

alteration from within the SMS message itself. The Applicants respectfully submit that, all things considered, there is no adequate suggestion or motivation to combine the teachings of the references as the Examiner suggests. There is also no motivation in the prior art to store a programmed indicator in an R-UIM. Thome et al. already provide a solution (i.e. use of the indicator in the SMS message itself) and no suggestion of any further problem to be solved.

In addition, there is no suggestion or motivation to combine the teachings of Thome et al. and Mittal in a further way as the Examiner may suggest. The Examiner stated that “[t]he method [of Mittal] involves transmitting a text message to a mobile station (10) over a network” as if to suggest that the text message itself is used to communicate parameters for programming. However, this is not the case. Parameters for programming the R-UIM in Mittal are performed after the receipt of a text message and not within any text message itself. In addition, Thome et al. describe a “UTC or Local Field 624” in each SMS message, on a message-by-message basis, which is different from a parameter in a programming mode during OTASP. The receipt of SMS messages in Thome et al. is not a programming mode. Thus, there is little suggestion or motivation to utilize OTASP for programming a “UTC or Local Field 624” indicator of Thome et al. in an R-UIM.

Finally, other teachings of Thome et al. are ambiguous regarding whether any timestamp mode indication is stored in memory. In particular, as described earlier, statements in paragraph 43 of Thome et al. are ambiguous as to whether any indication would be stored in non-volatile memory or R-UIM. For example, the mobile station could use the “UTC or Local Field 624” of the SMS message for making processing decisions. Also, the mobile station could be “configured” to have pre-programmed computer instructions to perform one of the particular operations described. The Examiner points out that Thome et al. describe various types of memory in paragraph 27; Thome et al., however, there is no association between any programmed indication and type of memory and device configuration. *If the Examiner is arguing inherency in Thome et al., then the Examiner has failed to articulate an inherency argument as*

required by the MPEP. Probabilities and possibilities in prior art teachings are insufficient for arguing inherency; the limitations must necessarily be present. Even assuming more, the programmed indication in the R-UIM of the present application relates to a UTC mode or non-UTC mode of operation of a home message center associated with the mobile device – which is not the same as any configuration of a mobile device to operate in some manner. Further, there is no and no stated suggestion or motivation to utilize OTASP for programming any such configuration of a mobile station of Thome et al. in an R-UIM.

In the same Office Action of 28 September 2006, the Examiner deemed such Office Action a Final Office Action. In response, the Applicants respectfully disagree with the indicated finality of such Office Action, and respectfully request that the present Amendment be entered in the present application for reconsideration of the application, for at least the following reasons.

According to the M.P.E.P., claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. See M.P.E.P 706.07(b).

In the present case, a Request for Continued Examination (RCE) was filed on 9 August 2006 contemporaneously with an Amendment to amend the pending claims and to add new claims. Such amended claims and new claims define new subject matter for further analysis and consideration; however, the Examiner issued a final Office Action on 28 September 2006.

The Applicants respectfully submit that the finality of the Office Action of 28 September 2006 is premature. For one, not all claims of the present application are drawn to the same inventive subject matter as earlier claimed. For example, many claims of the application were amended to recite specific differences, for example, that “the

indication [is] for use with Short Message Service (SMS) timestamps of each one of a plurality of SMS messages received via the home message center.” As another example, claim 27 was amended in the RCE Amendment as follows:

27. (Currently Amended) The mobile equipment of claim 23, ~~wherein the stored indicator in the memory of the removable user identity module is indicative of a timestamp mode of operation of a message center as one of a UTC mode and a non-UTC mode~~ further comprising:

for SMS messages sent from the ME, the processor being further operative to:

setting a timestamp in the SMS message as non-UTC time when the stored indicator in memory of the removable user identity module indicates that the timestamp mode of operation of the home message center is the non-UTC mode, and otherwise setting the timestamp in the SMS message as UTC time when the stored indicator in memory of the removable user identity module indicates that the timestamp mode of operation of the home message center is the UTC mode.

As apparent, the amended claims define subject matter that is not directed to the same inventive subject matter as earlier claimed.

Further, the Examiner did not properly reject all such claims. For example, with amended claim 27 above, the Examiner ignores the limitations and fails to articulate any rejection of the new limitations of amended claim 27 based on the prior art. As for other claims, for example, the Examiner fails to interpret the amended limitations (e.g. “the indication [is] for use with Short Message Service (SMS) timestamps of each one of a plurality of SMS messages received via the home message center”) according to their broadest reasonable interpretation to find teachings of the same in the prior art. The Examiner cannot proceed to issue a “first action, final” when the basis for the rejections using the same prior art is unsupported.

Based on the arguments provided herein, the Applicants respectfully submit that the pending claims are now allowable over the prior art of record. The Applicants respectfully submit that the application is in a condition suitable for allowance, and request for withdrawal of all rejections of claims.

The Applicants encourage the Examiner to contact the undersigned if it helps to expedite prosecution of the present application. Thank you.

Respectfully submitted,

/John J. Oskorep/

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JOHN J. OSKOREP
Reg. No. 41,234

JOHN J. OSKOREP, ESQ. LLC
ONE MAGNIFICENT MILE CENTER
980 N. MICHIGAN AVENUE, SUITE 1400
CHICAGO, ILLINOIS 60611 USA

Telephone: (312) 222-1860 Fax: (312) 475-1850